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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/592,462	06/09/2000	Tracy E. Grim	480032-307	4478

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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 02/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,462

Applicant(s)

GRIM ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 33-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 is/are allowed.
- 6) ☒ Claim(s) 33-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Reissue Applications

1. The reissue Declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP 1414.
2. The reissue Declaration filed with this application is defective (see 37 CFR 1.175 and MPEP 1414) because of the following:

The original Declaration is not relevant to the newly filed claims.

3. It is noted that applicant has requested that the requirement for new Declarations be deferred until claim language is finalized and thus such a requirement is deferred and will be required when the claims are finalized.

Specification

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

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© In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification, as originally filed, does not provide support for the invention as now claimed.

There is no basis in the original specification for “a heel portion that extends only partially up the heel of a user” as now claimed in claim 35.

There is no basis in the original specification for sections “with the height of said sections being at least equal to the width thereof” as now claimed in claims 39 and 42-44.

There is no basis in the original specification for a “closed heel/ankle” portion as now claimed in claims 42-44.

Claim Rejections - 35 USC § 112

5. Claims 35, and 39-44 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See above.

6. Claims 33-36, 38-44, and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claims 33, 36, and 38 the phrase “said resilient sections” lacks antecedent basis rendering the claims vague and indefinite.

Claim 35 is confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language. There does not appear to be any structure disclosed which would be described in such a manner.

In claim 38 the phrase “a material that resists compression-set” is vague and indefinite because it is not clear what structural limitations/materials applicant intends to encompass with such language.

In claim 39 the phrase “extends only part way up the heel and ankle” is confusing, vague, and indefinite and it is not clear what structural limitations applicant intends to encompass with such language.

In claims 42-44 the phrase “closed heel/ankle portion” is confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language.

In claims 42 and 43 the phrase “upper footgear surfaces for holding the foot into the footgear” is confusing, vague, and indefinite. How can a surface hold a foot? No structure as such as been disclosed. It is not clear what structural limitations applicant intends to encompass with such language.

In claim 46 the phrase “said shoe” lacks antecedent basis rendering the claim vague and indefinite.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 33-38, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellerman in view of Andrews (4793078) and Moronaga (4633598).

Kellerman shows a pad/footgear comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer substantially as claimed except for orienting the insert so that the removable resilient sections are an upper layer and making the inner sole sections from multiple layers. Andrews teaches orienting an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers' foot. Moronaga teaches forming an insole pad from three layers with progressively different softnesses. It would have been obvious to orient the insole/pad as taught by Andrews and to make the insole from three different layers as taught by Moronaga in the pad/footgear of Kellerman to better relieve pressure at regions of swelling, pain, or inflammation (as discussed in Kellerman in column 6 lines 4-7) and to provide better shock absorption and cushioning and to conform the insole to "suit the user's requirements" (column 2 lines 21-22)

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9. Claims 39, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim (5078128) in view of Kellerman and Andrews (4793078).

Grim shows a footgear comprising an outer sole (25), flaps and arrangement with an open toe (shown in figure 6), and an inner sole (200) substantially as claimed except for the exact inner sole. Grim suggests the use of customizing cushion construction in column 3 lines 42-45.

Kellerman teaches customizing cushion construction by providing a pad comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer for relieving pressure at regions of swelling, pain, or inflammation (column 6 lines 4-7). Andrews teaches orienting an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers foot. It would have been obvious to provide a pressure relieving insert insole as taught by Kellerman and to orient the insert as taught by Andrews in the footgear of Grim to relieve pressure at sensitive areas of a patients foot and thereby customize the cushion for the specific patient.

10. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 39 above, and further in view of Cavanagh (4608768).

Grim as modified above shows footgear substantially as claimed except for hook and loop fasteners on the bottom of the inner sole to connect it to the outer sole. Cavanagh teaches the use of hook and loop fasteners on the bottom of an inner sole to provide releasable secure connection of the inner sole to the footgear (column 4 lines 25-30). It would have been obvious to provide

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hook and loop fasteners as taught by Cavanagh in the footgear of Grim as modified above to provide secure and removable attachment for the inner sole.

11. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 39 above, and further in view of Moronaga (4633598).

Grim as modified above shows footgear substantially as claimed except for the inner sole being made from three layers. Moronaga teaches forming an inner sole from three layers with progressively different softness. It would have been obvious to make the inner sole sections from layers having different softness as taught by Moronaga in the footgear of Grim as modified above to provide better shock absorption and cushioning.

12. Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellerman in view of Andrews (4793078).

Kellerman shows footgear comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer substantially as claimed except for orienting the insert so that the removable resilient sections are an upper layer. Andrews teaches orienting an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers' foot. It would have been obvious to orient the insole/pad as taught by Andrews in the footgear of Kellerman to better relieve pressure at regions of swelling, pain, or inflammation (as discussed in Kellerman in column 6 lines 4-7) and to provide better shock absorption and cushioning and to conform the insole to "suit the user's requirements" (column 2 lines 21-22).

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13. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 42-45 above, and further in view of Cavanagh (4608768).

Kellerman as modified above shows footgear substantially as claimed except for hook and loop fasteners on the bottom of the inner sole to connect it to the outer sole. Cavanagh teaches the use of hook and loop fasteners on the bottom of an inner sole to provide releasable secure connection of the inner sole to the footgear (column 4 lines 25-30). It would have been obvious to provide hook and loop fasteners as taught by Cavanagh in the footgear of Kellerman as modified above to provide secure and removable attachment for the inner sole.

Allowable Subject Matter

14. Claims 1-23 are allowed.

Response to Amendment

15. The Declaration filed under 37 CFR 1.132 filed 12/8/01 is insufficient to overcome the rejection of the claims based upon the references as set forth in the last and this Office action because:

The Declaration appears to provide arguments towards a rejection of Andrews as an anticipatory reference (which no such rejection has been made) or an obviousness rejection based on Andrews in view of Kellerman (which no such rejection has been made). Therefore, this Declaration is not persuasive since it is not directed towards the rejections that have been made in the prior office action and this office action.

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Response to Arguments

16. Applicant's arguments filed 12/8/01 have been fully considered but they are not persuasive.

Applicant provide arguments directed towards Andrews as an anticipatory reference, Andrews has not been applied as such and therefore arguments directed towards such are not persuasive.

Applicant argues the specific areas of removable elements of Andrews, Kellerman (which is the base reference relied upon in the rejections) clearly shows and teaches providing removable sections of an innersole over substantially the entire sole area and clearly recites that this is desirable because "with time, the foot may change shape slightly, requiring a corresponding modification of the orthotic device" (column 1 lines 52-53) and "providing... surface that can be readily modified to provide windows in the cushioning in regions of swelling, pain, or inflammation" (column 6 lines 4-16), "The user may use the scale to establish and maintain the discrete and movable cushion elements at the best locations that he discovers with use" (column 7 lines 8-10), and "Even if the users foot shape requirements change with time, the kit of FIG. 22 allows continuing modification of the inserts to an optimal configuration" (column 7 lines 17-20). Kellerman is clearly directed towards an inner sole which has removable sections to alleviate symptoms of foot irritation, foot disease, rashes, etc.. Also, it is noted that Andrews clearly states that "the number, shape, and position of the depressions 18 and 18a may be chosen as best suited to the need of most users", see column 2 lines 10-15. Andrews also is directed towards an inner sole with removable sections so that "the user may readily and easily adapt to his individual need" (column 1 lines 16-17) and that the needs of the user may be "sensitive areas or regions on his

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foot where it is undesirable that pressure should be transmitted from the footwear via the insole” (column 1 lines 11-15). The combination of these references above clearly results in footgear as claimed and as recited in the above rejections.

Applicant’s request for an interview has been noted but since the Examiner, presently, doesn’t have any suggestions for amending the claims in order to put them in condition for allowance an interview hasn’t been initiated, see MPEP 713.01. Applicant is, respectively, invited to contact the Examiner upon review of the present office action to initiate an interview, if applicant still deems one necessary.


17. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, “should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners”, M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648.

For applicant’s convenience, the Group Technological Center FAX number is *703) 305-3580. Please identify Examiner ____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at “www.uspto.gov” for fees and other useful information.


Marie Patterson
Primary Examiner
Art Unit 3728